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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/754,376	01/05/2001	Takuji Yoshihiro	0505-0738P	3525
2292	7590	03/10/2006	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH			HENEGHAN, MATTHEW E	
PO BOX 747			ART UNIT	PAPER NUMBER
FALLS CHURCH, VA 22040-0747			2134	

DATE MAILED: 03/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/754,376

Applicant(s)

YOSHIHIRO, TAKUJI

Examiner

Matthew Heneghan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 December 2005.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5, 7-11, 14-17 and 20-25 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☒ Claim(s) 25 is/are allowed.  
6) ☒ Claim(s) 1-4, 7-11, 14-17, 20 and 22-24 is/are rejected.  
7) ☒ Claim(s) 5 and 21 is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 18 February 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 23 November 2005 has been entered.
2. In response to the previous office action, Applicant has amended claims 1, 5, 20, and 21; cancelled claim 6; and added claim 25. Claims 1-5, 7-11, 14-17, and 20-25 have been examined.

### ***Claim Rejections - 35 USC § 112***

3. In view of Applicant's amendments, all previous rejections under 35 U.S.C. 112, second paragraph are withdrawn.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 2, 4, 9-11, and 14-17 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,606,609 to Houser et al.

Houser discloses a document verification method in which security information (a reference characteristic) derived from a document digest is embedded into a document, and later extracted and compared to a calculated document digest (a comparison subject characteristic value) to verify (the determining means) the document (see abstract). A document received from another system may be verified using the copy having the private key signature by the original signator (the first computer system) (see column 15, lines 7-9 and column 19, lines 11-40). Houser discloses that this operation is performed upon a “received” document (see column 7, line 66); based upon the fact that Houser discloses the use of a network (see column 8, lines 58-62) and that the prior art discusses the passing of documents between different computers on a network (see column 1, lines 24-31), a reasonable interpretation of the word “received” in this context is that the document is being received from another computer (the second computer).

As per claims 4 and 14-17, the security information may be a hash value (see column 4, lines 20-34). If the document is graphical (i.e. a drawing), a watermark may

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be embedded (see column 4, lines 52-60). All copies show the same document, so they are all drawing data.

As per claims 9-11, the embedded information may be created using a public key encryption algorithm (see column 4, lines 3-10).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-4, 7-11, 14-17, 20, and 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,246,778 to Moore in view of U.S. Patent No. 5,606,609 to Houser et al. further in view of U.S. Patent No. 6,052,669 to Smith et al.

Regarding claims 1-3 and 20, Moore discloses an authentication system that includes a scenario wherein authentication information is used to authenticate a piece of merchandise to either a supplier or a customer (see claim 9). The authenticating of an item is done by a manufacturer's field computer referencing the manufacturer's database (see abstract). Applicant's specification defines a manufacturer's computer system possibly comprises a plurality of computer systems (see Specification, p. 6, lines

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19-21); therefore the field computer and database computer in conjunction constitute a manufacturer's computer, as they are clearly parts of the same system.

Moore does not disclose the exact algorithm by which the authentication is performed.

Houser discloses a document verification method in which security information (a reference characteristic) derived from a document digest is embedded into a document, and later extracted and compared to a calculated document digest (a comparison subject characteristic value) to verify (the determining means) the document (see abstract).

Houser further suggests that this gives a system that is user-friendly and deters forgery and alterations (see column 3, lines 41-45).

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Moore by using the technique disclosed by Houser, in order to yield a system that is user-friendly and deters forgery and alterations.

Regarding claims 4 and 14-17, the security information may be a hash value (see Houser, column 4, lines 20-34). If the document is graphical (i.e. a drawing), a watermark may be embedded (see column 4, lines 52-60). All copies show the same document, so they are all drawing data.

Regarding claims 9-11, the embedded information may be created using a public key encryption algorithm (see Houser, column 4, lines 3-10).

Regarding claims 7 and 8, Moore and Houser also do not disclose the submission of an order based upon an electronic drawing.

Smith discloses a system where a CAD system (which generates electronic drawings) is used by a customer to generate an order to be submitted (see column 5, lines 36-53), and suggests that this is superior to the task being performed via a sales representative, which can take many sales calls and design iterations (see column 2, lines 9-40).

Therefore it would have obvious to one of ordinary skill in the art at the time the invention was made to use the invention of Moore and Houser for a CAD-based ordering system, as disclosed by Smith, as this is superior to the task being performed via a sales representative, which can take many sales calls and design iterations.

Regarding claim 22-24, the private key algorithm disclosed by Houser requires that the determination be made on the first computer system, since the key is private to that system. Since the other types of encoding (e.g. public key) are not essential to Houser's invention, an invention having only the private key functionality is rendered obvious.

***Allowable Subject Matter***

6. Claim 25 is allowed.

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7. Claims 5 and 21 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. The following is a statement of reasons for the indication of allowable subject matter: Though the previously cited Schwab discloses a comparison for three-dimensional geometry, Schwab does not use a laser or inspection needle to derive it. No other art could be found disclosing these features that one skilled in the art would reasonably combine with the other cited art.

### ***Response to Arguments***

9. Applicant's arguments, see Remarks, filed 23 November 2005, with respect to the rejections of the claims under 35 U.S.C. 102 and 103 have been fully considered. The arguments regarding claims 5, 21, and 25 are persuasive in view of Applicant's amendments. Therefore, the rejections of claims 5 and 21 have been withdrawn. Regarding the remaining claims, the grounds of rejections over Houser have been modified in view of Applicant's amendments. The "second computer system," as discussed above, is inherent in Houser.

### ***Conclusion***



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10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew E. Heneghan, whose telephone number is (571) 272-3834. The examiner can normally be reached on Monday-Friday from 8:30 AM - 4:30 PM Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu, can be reached at (571) 272-3859.

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
P.O. Box 1450  
Alexandria, VA 22313-1450

**Or faxed to:**

(571) 273-3800

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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February 23, 2006



HOSUK SONG  
PRIMARY EXAMINER